

REMARKS

The Examiner is thanked for the performance of a thorough search. By this amendment, Claims 1, 4, 38, and 39 have been amended. No claims have been added. No claims have been canceled. Hence, Claims 1–72 are pending in this application.

All issues raised in the Office Action are addressed hereinafter.

I. DISQUALIFICATION OF *HOSEA* AS PRIOR ART

The Office Action rejected each of Claims 1–72 as obvious over a combination of U.S. Patent Application No. 2002/0138331 (hereinafter *Hosea*), filed Feb. 5, 2001, and various other references. Concurrent with this response, Applicants have submitted evidence that shows that *Hosea* does not qualify as prior art, and therefore cannot serve as a basis for rejections of the present claims.

The evidence submitted herewith proves that:

(1) the subject matter of Claims 1–72 was conceived of prior to the filing date of *Hosea* (see Exhibit 1, page 2; compare Exhibit 1 with final pages of provisional application number 60/269,699);

Applicants filed provisional application number 60/269,699, that supports the present claims, and from which the current application claims priority, on February 17, 2001, thereby constructively reducing the subject matter of Claims 1–72 to practice. Note that provisional application number 60/269,699 includes, verbatim, pages 4–17 of Exhibit 1, complete with a copyright date of Jan. 17, 2001.

Applicants exercised due diligence in reducing the invention to practice from at least a time prior to filing date of *Hosea*, lasting until at least Applicant's filing of the provisional application (compare dates on page 2 with filing date of provisional application number 60/269,699). Therefore, *Hosea* cannot therefore qualify as prior art under 35 U.S.C. 103(a).

Because *Hosea* does not qualify as prior art for purposes of 35 U.S.C. 103, it cannot be used as a basis of rejection under 35 U.S.C. 103. Therefore, all pending rejections have been rendered moot.

II. CLAIM REJECTIONS BASED ON 35 U.S.C. § 103

Because *Hosea* does not qualify as prior art, the § 103 rejections are moot. However, to expedite the positive resolution of this case, arguments are provided hereafter to explain why the current claims are patentable **even if** *Hosea* qualified as prior art, which it does not.

A. *Obviousness under 35 U.S.C. § 103(a): Hosea and Liu.*

Claims 1 and 38 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent Application No. 2002/0138331 (hereinafter *Hosea*) in view of U.S. Patent Application No. 2002/0027901 (hereinafter *Liu*). This rejection is respectfully traversed.

INDEPENDENT CLAIM 1

Claim 1, as set forth in the listing of claims, clarifies that the method features, among other elements:

intercepting a message that has been sent from a first participant to a second participant prior to said message arriving at said second participant;
wherein intercepting the message is performed by a device coupled between a plurality of clients and a plurality of servers, wherein the message is addressed to said second participant and **not to said device**;

...

on said device, determining whether said message has billing implications;
on said device, if said message has billing implications, using said identity to maintain a log of the interaction between said first participant by said second participant, wherein said interaction involves one or more messages sent by the first

participant that are addressed to the second participant, and one or more messages sent by the second participant that are addressed to the first participant; and wherein said log is based at least in part on reply messages that pass through said device.

The steps of Claim 1 may be used, for example, by an HTTP proxy to determine how a service provider should bill a customer for accessing the service provider's services. An HTTP proxy that implemented the method of Claim 1 would be configured to intercept a message that is not addressed to the HTTP proxy. Unlike conventional HTTP proxies, the HTTP proxy would also be configured to determine an identity of a participant based on information in the message (such as the message IP address). The HTTP proxy would also have to be configured to determine whether or not the message has billing implications. For example, the HTTP proxy may do this by analyzing the content of the message to see if the message corresponds to the purchase of a service. If the message has billing implications, then the HTTP proxy logs interactions between the service provider and customer, based at least in part on replies to the first intercepted message.

The combination of *Hosea* and *Liu* fails to teach or suggest a number of features of Claim 1.

- (1) Liu does not disclose intercepting a message “wherein the message is addressed to said second participant and not to said device.”

The Office Action alleges that *Liu* discloses “wherein the message is addressed to said participant and not to said device” by virtue of *Liu* at ¶ [0040], where “Participant A is . . . advising participant C as to fishing skills, which advice if [sic] provided via email.” The Office Action alleges that because “that the verb ‘to address’ has a broader yet reasonable interpretation as ‘to direct towards,’” this fishing advice is “addressed to Participant C.”

However, even if *Liu*'s fishing advice could be said to be addressed to Participant C, the Office Action fails to explain how the fishing advice is “**not [addressed] to said device,**” as required by Claim 1. For *Liu*'s anonymous communication system to be operative, all messages—regardless of their form—must be addressed to *Liu*'s controller unit 24. *See, e.g., Liu* at ¶ [0092] (“the designated caller typically initiates contact with other users via the controller

unit 24”); *Liu* at ¶ [0104] (“the unit 24 is enabled to manage and otherwise direct voice communication between users”).

In other words, *Liu*’s device cannot “intercept a message” for purposes of generating a communications record unless the message is addressed to the device. If messages are not addressed to *Liu*’s device, the device will never see the message. Thus, the device would be unable to complete the step of generating communications records, which step the Office Action alleges to teach Claim 1’s step of “maintain[ing] a log.” Therefore, *Liu* does not teach “intercepting a message” within the meaning of Claim 1, in that *Liu*’s messages are always addressed to the device alleged to perform the interception.

(2) The references do not disclose “determining whether said message has billing implications.”

Claim 1 presently recites a step of “on said device, determining whether said message has billing implications.” The Office Action has admitted that this step, formerly recited Claim 4, is not taught by *Hosea* or *Liu*. Thus, Claim 1 is patentable over the combination of *Hosea* and *Liu*.

Nonetheless, the Office Action alleges that U.S. Patent No. 2002/0133412 (hereinafter *Oliver*) discloses such a step. Specifically, the Office Action alleges that this step is taught in *Oliver*, ¶ [0114], which allegedly describes checking a message for a token. The Office Action apparently misunderstands how *Oliver*’s invention operates. In *Oliver*, a token is included in a message between a user and a client device. See message 5 of FIG. 1. The client device receives this message and then sends the token, without the message, to a Clickshare Service, executing on a different server device, for validation.

Oliver’s messages are never intercepted. The client is the intended recipient of the message. Meanwhile, the Clickshare Service never even sees the message from the user. Since *Oliver*’s messages are not intercepted, *Oliver*’s messages are not “the message” within the meaning of Claim 4. For this reason alone, neither *Oliver*’s client nor *Oliver*’s Clickshare Service determines whether an intercepted message has billing implications.

Furthermore, *Oliver*’s tokens do not have billing implications. Rather, *Oliver*’s tokens are used solely to validate a user. The fact that a message was sent with a token does not mean that the message has billing implications. For example, a user may be validated without being

billed. As another example, a message may have a token, but the token may not validate, and thus would not implicate billing in any way. Thus, neither *Oliver*'s client nor *Oliver*'s Clickshare Service determines whether a message has billing implications.

(3) The references do not disclose that maintaining a log occurs “if said message has billing implications.”

Claim 1 presently recites a step of “on said device, if said message has billing implications, using said identity to maintain a log of the interaction.” The Office Action has admitted that this step, formerly recited Claim 4, is not taught by *Hosea* or *Liu*. Thus, Claim 1 is patentable over the combination of *Hosea* and *Liu*.

Nonetheless, the Office Action alleges that *Oliver* discloses such a step. Specifically, the Office Action alleges that this step is taught in *Oliver*, ¶ [0114], which is alleged to describe checking a message for a token, and in ¶¶ [0276]–[0300], which describe the Clickshare Log Format.

Claim 1 specifically requires that a log be maintained only “if said message has billing implications.” However, while the Clickshare log may subsequently be used to determine billing information, the Clickshare log is kept for “each access,” *Liu* at ¶ [0277], regardless of whether the access is related to billing, and even regardless of the validity of the token for which validation is requested. Thus, the Clickshare log is not maintained “if said message has billing implications,” as required by Claim 1.

Furthermore, the log must be maintained on the same device as the device determining “if said message has billing implications.” *Liu*'s Clickshare Service maintains the log. Yet, since, as mentioned above, *Liu*'s Clickshare Service never even sees “said message,” the determination “if said message has billing implications” is not performed on the device executing the Clickshare Service. Thus, *Liu* does not teach determining “if said message has billing implications” and “maintain[ing] a log of the interaction” on the same device.

For at least the foregoing reasons, the combination of *Hosea* and *Liu* fails to teach or suggest at least one feature of independent Claim 1. Therefore, the combination of *Hosea* and *Liu* does not render Claim 1 obvious under 35 U.S.C. § 103. Reconsideration is respectfully requested.

INDEPENDENT CLAIM 38

Independent Claim 38 also recites features argued above with relation to Claim 1, although Claim 38 is expressed in another format. Because Claim 38 has at least one of the features described above for Claim 1, Claim 38 is therefore allowable over the combination of *Hosea* and *Liu* for at least one of the same reasons as given above for Claim 1. Reconsideration is respectfully requested.

B. Obviousness under 35 U.S.C. § 103(a): Hosea, Liu, and Oliver.

Claims 2-7, 11-24, 26-28, 31-33, 39-42, 46-59, 61-63 and 66-68 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Hosea* and *Liu* in view of U.S. Patent No. 2002/0133412 (hereinafter *Oliver*). The rejection is respectfully traversed.

Each of Claims 2-7, 11-24, 26-28, 31-33, 39-42, 46-59, 61-63 and 66-68 is dependent upon independent Claims 1 or 38. As discussed in section II.A above, the combination of *Hosea* and *Liu* fails to teach or suggest one or more features of Claims 1 and 38. The one or more features, identified above, which are missing from the combination of *Hosea* and *Liu*, are also missing from *Oliver*. In fact, the Office Action did not rely upon *Oliver* for teaching the one or more features. Consequently, the combination of *Hosea*, *Liu*, and *Oliver* fails to teach or suggest one or more features of Claims 2-7, 11-24, 26-28, 31-33, 39-42, 46-59, 61-63 and 66-68. Thus, Claims 2-7, 11-24, 26-28, 31-33, 39-42, 46-59, 61-63 and 66-68 are patentable over the combination of *Hosea*, *Liu*, and *Oliver*.

Additionally, each of the dependent claims recites at least one additional feature that independently renders it patentable over the combination of *Hosea*, *Liu*, and *Oliver*.

DEPENDENT CLAIM 2

For example, Claim 2 recites a step of “identifying which services are being provided to said clients by said servers based on the content of messages.” The Office Action alleges that *Hosea* discloses such a step in ¶ [0037], which describes extracting a URL from the message. Although, as mentioned in section I above, *Hosea* is disqualified as prior art, Applicants wish to

clarify that extracting a URL is not “identifying which services are being provided to said clients by said servers based on the content of messages.” A URL does not reveal which service is being requested. For example, the URL may be a number, such as, http://10.1.17.8, that in and of itself reveals nothing about the requested service. Or, a single URL may offer a variety of services, such as a stock quote service and a news service. In fact, *Hosea* says nothing about identifying any service being provided to a client.

DEPENDENT CLAIM 13

As another example, Claim 13 recites steps of “determining a service class” and “determining where to direct said message to based on said service class.” The Office Action alleges that *Oliver* discloses these steps in ¶ [0100]. This is not true. *Oliver* mentions that Clickshare “feels” that users “will want different classes of service.” *Oliver* even mentions that “it is possible to develop very low-level class-of- and quality-of-service levels.” But *Oliver* makes no further mention of service classes, other than that “classing is not yet well-defined” and that “Clickshare intends to work with its early partners on such developments.” Thus, ¶ [0100] describes **nothing more than Clickshare’s wish to provide service classing in the future.**

Oliver, then, neither teaches nor suggests any steps to be performed with regards to “a service class.” *Oliver* does not, for example, teach to determine a service class based on an identity determined from identifier information in an intercepted message. Nor does *Oliver* teach or suggest that, once a service class is determined, the intercepting device should “direct said message . . . based on said service class.”

OTHER DEPENDENT CLAIMS

To expedite prosecution in light of the fundamental differences already identified, further arguments for each independently patentable feature of Claims 2-7, 11-24, 26-28, 31-33, 39-42, 46-59, 61-63 and 66-68 are not provided at this time. Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

C. *Obviousness under 35 U.S.C. § 103(a): Hosea, Liu, Olivier, and Manabe.*

Claims 8, 10, 43 and 45 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Hosea* in view of *Liu* and *Oliver* and further in view of U.S. Patent No. 5,339,239 (hereinafter *Manabe*). The rejection is respectfully traversed.

Each of Claims 8, 10, 43 and 45 is dependent upon independent Claims 1 or 38. As discussed in section II.A above, the combination of *Hosea* and *Liu* fails to teach or suggest one or more features of Claims 1 and 38. The one or more features, identified above, which are missing from the combination of *Hosea* and *Liu*, are also missing from *Oliver* and *Manabe*. In fact, the Office Action did not rely upon *Oliver* or *Manabe* for teaching the one or more features. Consequently, the combination of *Hosea*, *Liu*, *Oliver*, and *Manabe* fails to teach or suggest one or more features of Claims 8, 10, 43 and 45. Thus, Claims 8, 10, 43 and 45 are patentable over the combination of *Hosea*, *Liu*, *Oliver*, and *Manabe*.

Additionally, each of the dependent claims recites at least one additional feature that independently renders it patentable over the combination of *Hosea*, *Liu*, *Oliver*, and *Manabe*. However, to expedite prosecution in light of the fundamental differences already identified, further arguments for each independently patentable feature of Claims 8, 10, 43 and 45 are not provided at this time. Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

D. *Obviousness under 35 U.S.C. § 103(a): Hosea, Liu, Olivier, Manabe, and Hartley.*

Claims 9 and 44 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Hosea* in view of *Liu* and *Oliver* and *Manabe* and U.S. Patent No. 6,167,385 (hereinafter *Hartley*). The rejection is respectfully traversed.

Each of Claims 9 and 44 is dependent upon independent Claims 1 or 38. As discussed in section II.A above, the combination of *Hosea* and *Liu* fails to teach or suggest one or more features of Claims 1 and 38. The one or more features, identified above, which are missing from the combination of *Hosea* and *Liu*, are also missing from *Oliver*, *Manabe*, and *Hartley*. In fact, the Office Action did not rely upon *Oliver*, *Manabe*, or *Hartley* for teaching the one or more

features. Consequently, the combination of *Hosea*, *Liu*, *Oliver*, *Manabe*, and *Hartley* fails to teach or suggest one or more features of Claims 9 and 44. Thus, Claims 9 and 44 are patentable over the combination of *Hosea*, *Liu*, *Oliver*, *Manabe*, and *Hartley*.

Additionally, each of the dependent claims recites at least one additional feature that independently renders it patentable over the combination of *Hosea*, *Liu*, *Oliver*, *Manabe*, and *Hartley*. However, to expedite prosecution in light of the fundamental differences already identified, further arguments for each independently patentable feature of Claims 9 and 44 are not provided at this time. Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

E. *Obviousness under 35 U.S.C. § 103(a): Hosea, Liu, Olivier, and Clarke.*

Claims 25 and 60 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Hosea* in view of *Liu* and *Oliver* and in further view of U.S. Patent No. 5,502,636 (hereinafter *Clarke*). The rejection is respectfully traversed.

Each of Claims 25 and 60 is dependent upon independent Claims 1 or 38. As discussed in section II.A above, the combination of *Hosea* and *Liu* fails to teach or suggest one or more features of Claims 1 and 38. The one or more features, identified above, which are missing from the combination of *Hosea* and *Liu*, are also missing from *Oliver* and *Clarke*. In fact, the Office Action did not rely upon *Oliver* or *Clarke* for teaching the one or more features. Consequently, the combination of *Hosea*, *Liu*, *Oliver*, and *Clarke* fails to teach or suggest one or more features of Claims 25 and 60. Thus, Claims 25 and 60 are patentable over the combination of *Hosea*, *Liu*, *Oliver*, and *Clarke*.

Additionally, each of the dependent claims recites at least one additional feature that independently renders it patentable over the combination of *Hosea*, *Liu*, *Oliver*, and *Clarke*. However, to expedite prosecution in light of the fundamental differences already identified, further arguments for each independently patentable feature of Claims 25 and 60 are not provided at this time. Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

F. *Obviousness under 35 U.S.C. § 103(a): Hosea, Liu, and Hahn.*

Claims 29, 30, 64 and 65 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Hosea* in view of *Liu* and in further view of U.S. Patent No. 6,704,612 (*Hahn*). The rejection is respectfully traversed.

Each of Claims 29, 30, 64 and 65 is dependent upon independent Claims 1 or 38. As discussed in section II.A above, the combination of *Hosea* and *Liu* fails to teach or suggest one or more features of Claims 1 and 38. The one or more features, identified above, which are missing from the combination of *Hosea* and *Liu*, are also missing from *Hahn*. In fact, the Office Action did not rely upon *Hahn* for teaching the one or more features. Consequently, the combination of *Hosea*, *Liu*, and *Hahn* fails to teach or suggest one or more features of Claims 29, 30, 64 and 65. Thus, Claims 29, 30, 64 and 65 are patentable over the combination of *Hosea*, *Liu*, and *Hahn*.

Additionally, each of the dependent claims recites at least one additional feature that independently renders it patentable over the combination of *Hosea*, *Liu*, and *Hahn*. However, to expedite prosecution in light of the fundamental differences already identified, further arguments for each independently patentable feature of Claims 29, 30, 64 and 65 are not provided at this time. Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

G. *Obviousness under 35 U.S.C. § 103(a): Hosea, Liu, Olivier, and Block.*

Claims 34, 35, 69 and 70 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Hosea* in view of *Liu* and *Oliver* and U.S. Patent No. 5,960,416 (hereinafter *Block*). This rejection is respectfully traversed. The rejection is respectfully traversed.

Each of Claims 34, 35, 69 and 70 is dependent upon independent Claims 1 or 38. As discussed in section II.A above, the combination of *Hosea* and *Liu* fails to teach or suggest one or more features of Claims 1 and 38. The one or more features, identified above, which are missing from the combination of *Hosea* and *Liu*, are also missing from *Oliver* and *Block*. In fact, the Office Action did not rely upon *Oliver* or *Block* for teaching the one or more features. Consequently, the combination of *Hosea*, *Liu*, *Oliver*, and *Block* fails to teach or suggest one or

more features of Claims 34, 35, 69 and 70. Thus, Claims 34, 35, 69 and 70 are patentable over the combination of *Hosea, Liu, Oliver, and Block*.

Additionally, each of the dependent claims recites at least one additional feature that independently renders it patentable over the combination of *Hosea, Liu, Oliver, and Block*. However, to expedite prosecution in light of the fundamental differences already identified, further arguments for each independently patentable feature of Claims 34, 35, 69 and 70 are not provided at this time. Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

H. Obviousness under 35 U.S.C. § 103(a): Hosea, Liu, and Tealdi.

Claims 36 and 71 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Hosea* in view of *Liu* further in view of U.S. Patent Application No. 2001/0029482 (hereinafter *Tealdi*). This rejection is respectfully traversed. The rejection is respectfully traversed.

Each of Claims 36 and 71 is dependent upon independent Claims 1 or 38. As discussed in section II.A above, the combination of *Hosea* and *Liu* fails to teach or suggest one or more features of Claims 1 and 38. The one or more features, identified above, which are missing from the combination of *Hosea* and *Liu*, are also missing from *Tealdi*. In fact, the Office Action did not rely upon *Tealdi* for teaching the one or more features. Consequently, the combination of *Hosea, Liu, and Tealdi* fails to teach or suggest one or more features of Claims 36 and 71. Thus, Claims 36 and 71 are patentable over the combination of *Hosea, Liu, and Tealdi*.

Additionally, each of the dependent claims recites at least one additional feature that independently renders it patentable over the combination of *Hosea, Liu, and Tealdi*. However, to expedite prosecution in light of the fundamental differences already identified, further arguments for each independently patentable feature of Claims 36 and 71 are not provided at this time. Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

I. *Obviousness under 35 U.S.C. § 103(a): Hosea, Liu, Olivier, and Tealdi.*

Claims 37 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Hosea* in view of *Liu*, and *Tealdi* further in view of *Oliver*. The rejection is respectfully traversed.

Each of Claims 37 and 72 is dependent upon independent Claims 1 or 38. As discussed in section II.A above, the combination of *Hosea* and *Liu* fails to teach or suggest one or more features of Claims 1 and 38. The one or more features, identified above, which are missing from the combination of *Hosea* and *Liu*, are also missing from *Oliver* and *Tealdi*. In fact, the Office Action did not rely upon *Oliver* or *Tealdi* for teaching the one or more features. Consequently, the combination of *Hosea*, *Liu*, *Oliver*, and *Tealdi* fails to teach or suggest one or more features of Claims 37 and 72. Thus, Claims 37 and 72 are patentable over the combination of *Hosea*, *Liu*, *Oliver*, and *Tealdi*.

Additionally, each of the dependent claims recites at least one additional feature that independently renders it patentable over the combination of *Hosea*, *Liu*, *Oliver*, and *Tealdi*. However, to expedite prosecution in light of the fundamental differences already identified, further arguments for each independently patentable feature of Claims 37 and 72 are not provided at this time. Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

III. ADDED CLAIMS / AMENDMENTS

The added claims and amendments to the claims do not add any new matter to this application. The amendments to Claims 1, 4, 38, and 39 are supported by at least Applicants' original claims 4 and 39. The amendments to the claims were made to improve the readability and clarity of the claims and not necessarily for any reason related to patentability.

IV. CONCLUSION

For the reasons set forth above, all of the pending claims are now in condition for allowance. The Examiner is respectfully requested to contact the undersigned by telephone relating to any issue that would advance examination of the present application.

A petition for extension of time, to the extent necessary to make this reply timely filed, is hereby made. If applicable, a check for the petition for extension of time fee and other applicable fees is enclosed herewith. If any applicable fee is missing or insufficient, throughout the pendency of this application, the Commissioner is hereby authorized to any applicable fees and to credit any overpayments to our Deposit Account No. 50-1302.

Respectfully submitted,
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